

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Dante E. PICCONE

Atty. Docket No.: 105773.0132

Original Patent No.: 5,614,737

Patent No.: RE36770

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Application No.: 09/273,567

For: MOS-CONTROLLED HIGH-POWER
THYRISTOR

Filed: March 22, 1999

**STATEMENT BY SUEANNE GILL IN SUPPORT OF PETITION FOR
RECONSIDERATION UNDER 37 C.F.R. § 1.378(B)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The undersigned hereby states that:

1. I was employed as the Annuities / Maintenance Fee Clerk by the law firm of Blank Rome LLP ("the firm") from July 16, 2003 to June 7, 2004. My name at that time was SueAnne Sopko.

2. The position of Maintenance Fee Clerk was part of the Docketing Department. During my tenure at the firm, Linda Bynum-Cosby was the head of the Docketing Department. Accordingly, I was trained in my position as a Maintenance Fee Clerk by Ms. Cosby. Immediately prior to working at the firm, I was employed as a patent secretary, which included the responsibilities of filing papers (including applications, amendments, petitions, etc.) with the PTO, and preparing correspondence to clients. Since working at the firm, I have been employed in intellectual property, including docketing or maintenance fee responsibilities (at another intellectual property law firm and at a company) until about May 2007, when I started my family.

3. Ms. Cosby was very knowledgeable about the patent process and patent docketing procedures, and was very competent in her job. In addition, Ms. Cosby was compulsive in performing her job as best as she could, and was extremely detail-oriented in docketing each and

every case. In fact, it was office humor in the docketing department to ridicule one another about being "obsessive compulsive" in our work. Accordingly, it is my opinion that Ms. Cosby was reliable, and that the firm was reasonable and exercised due care to protect its most important business, including the present patent, by entrusting Ms. Cosby as its head of the docketing department.

4. As a Maintenance Fee Clerk, I was responsible to make payment of all U.S. patent maintenance fees that were due. My responsibilities also included: creating and assembling the maintenance fee file (with a copy of the patent face and any maintenance-fee-related correspondence); initiating system generation of client reminder letters through the maintenance fee module software; receiving and tracking receipt of client instructions (to pay or not to pay the maintenance fee); making sure that the Docketing Department was in possession of the client instructions by the due date for docket clearing purposes; initiating generation of instruction acknowledgement letters (and invoices, where applicable) to the client through the add-on maintenance fee module; where the client instructions were to pay, preparing the maintenance fee transmittal, confirmation postcard and obtaining the necessary check or credit card authorization form from the firm's Accounting Department; obtaining attorney signature and submitting the signed documents and fees to docketing for review and hand delivery (by the firm's appointed courier) or facsimile transmission to the U.S. Patent and Trademark Office; and confirming that the confirmation postcard was stamped received by the U.S. Patent and Trademark Office. Though I did not have any docketing responsibilities, I became familiar with the firm's docketing procedures (especially as related to maintenance fees) by closely working with the docketing clerks, including Ms. Cosby, and reviewing docketing reports and docketed deadlines.

5. During my employment, the firm's system for attending to the payment of maintenance fees operated as follows. The firm used Thomson Master Data Center's IPMaster™ docketing software to maintain its case records and track due dates. When the firm first received an official notice of a grant date and patent number, normally upon receipt of the official Issue Notification, a docketing clerk was responsible for entering this information into the case record in the grant date field.

6. The firm's system included a software add-on maintenance fee program developed by Mind's Eye Development, which interfaced with the basic docketing software. The module containing this add-on software provided a maintenance fee clerk with an independent tracking

mechanism for maintenance fees, as well as for generating client reminder and instruction acknowledgement letters.

7. Any post-issue communications mailed by the Office, for example, Maintenance Fee Reminders and Notices of Patent Expiration, were noted in the IPMaster™ software. Upon receipt of a Notice of Non-Acceptance of Payment, a response due date would be docketed in the "actions" tab of the software.

8. All of the above entries, were revisited and reconfirmed upon receipt of an original Letters Patent. Based upon my experience, the docketing aspects of the firm's maintenance fee payment system were sound, reliable, trustworthy, securely redundant, effective, reasonable and the exercise of due care to be relied upon to track the firm's most important business.

9. It was not the firm's practice to docket status checks for maintenance fee statements and deposit account activity for maintenance fees believed to be paid on time. Rather, under the firm's system, anomalies, inconsistencies, questions and the like were to be resolved prior to taking action, but the docket record indications in general were to be reconciled with the maintenance fee files as soon as possible and definitely before any due date was cleared from the docket.

10. To secure this safeguard, I was required to make sure that the Docketing Department was in possession of the client's instructions required to clear the docket so that the maintenance fee file information would be added to the electronic file record to ensure the docket was cleared based on a complete and correct record, with any discrepancies having been resolved and removed expeditiously.

11. At the time of my employment, separate maintenance fee files were kept in addition to the firm's main prosecution files in order to streamline and simplify the maintenance fee tracking and payment process and its associated recordkeeping. All and only maintenance-fee-related documents were kept in those files. Also, unlike the firm's general prosecution files, maintenance fee files were created, maintained and stored by and in the maintenance fee clerk's file cabinets. All firm maintenance fee clerks were therefore intimately familiar with these files and aware that reference to them is essential for any information and instructions relating to maintenance fee payment (or nonpayment) in any given case.

12. Based on my IP experience, the above-described procedures were sufficient to docket and monitor maintenance fee due dates and payments and employment of additional safeguards were not required. Moreover, it is my opinion that the software and docketing procedures were

reliable and trustworthy to track relevant deadlines including the deadline to pay maintenance fees. The above shows that the firm established and maintained reasonable safeguards to ensure that the maintenance fee clerks had ready access to all pertinent information in the payment of maintenance fees and that the firm took all reasonable precautions to ensure that the maintenance fees would be timely paid. Accordingly, it is my opinion that there was in place a business routine for performing the clerical function of paying maintenance fees, and that the business routine, could be relied upon to avoid errors in its performance, and was reliable and trustworthy for the firm's most important business.

13. Based on my review of the documents, which are attached as Exhibits A-F to this Statement, two errors led to an unavoidable delay in the 3.5 year and 7.5 year maintenance fee payments of the subject patent and occurred during the period of my employment. The first error occurred sometime in 2000 during the process of docketing maintenance fees. The second error occurred sometime in 2004 when the first error was discovered and corrected, but the maintenance fee record was not properly reviewed. A chronology of the events described hereinbelow is attached as Exhibit A.

14. In the present case, a first error occurred in that the 3.5 year maintenance fee was not docketed properly. As noted above, it was standard practice to enter the patent grant date into Thomson Master Data Center's IPMaster™ for calculation of maintenance fee due dates upon receipt of an Issue Notification. The Issue Notification for the subject patent was received on June 28, 2000. However, the Issue Notification was not properly processed. Based upon my review of the documents, it appears that it was not noted during the docketing of the maintenance fees that the subject patent was a reissue patent, and the docketing entry at the time of receiving the Reissue Notification mistakenly changed the year (but not the month and day) to that of the Reissue. Consequently, the 3.5 year maintenance fee was erroneously docketed for September 25, 2004 (instead of September 25, 2000), *i.e.*, based on the year of the reissue patent rather than the issue year of the original patent. (The month and date of the erroneous date were correctly based on the original patent.) A copy of the Issue Notification with the Blank Rome "Docketing" stamp contains a notation indicating that maintenance fees were docketed for these dates is attached hereto as Exhibit B. As indicated on the Issue Notification, the 3.5 year, 7.5 year and 11.5 year maintenance fees were erroneously docketed for September 25, 2004, September 25, 2008, and September 25, 2012, respectively (rather than September 25, 2000, September 25, 2004 and September 25, 2008).

15. That erroneous docket entry was made by Ms. Cosby, as confirmed by her handwritten initials "LBC" on the docketing notation made on Exhibit B. It is my opinion that this error is understandable, even for the firm's most important business, since at the time of the docket entry (November 2000), the correct 3.5 year deadline (September 25, 2000) had already passed (though the 4 year deadline had not). In addition, it should be recognized that Reissue and Reexamination proceedings are rather rare, and the PTO procedures are complicated and different than for normal utility patents. Had this been a normal utility patent, and not a reissue patent, it is unlikely that any error would have occurred.

16. Due to the errors in docketing, the correct 3.5 year maintenance fee due date was not entered into the docketing and maintenance fee software and the software did not generate a reminder in advance of the correct 3.5 year (September 25, 2000) due date or the 4 year (March 25, 2001) maintenance fee grace deadline. Consequently, the docketed deadline was September 25, 2004, for the 3.5 year maintenance fee, which was three years after the actual deadline of March 25, 2001 (including the six-month grace period). As a result of this clerical error in entering the base date for maintenance fee due date calculation, the 3.5 year maintenance fee was not paid and the maintenance fee clerk and docketing staff were not alerted to the failure to make a payment.

17. Apparently, as the erroneous September 25, 2004, deadline drew near, the error in docketing maintenance fee due dates was noted and corrected as part of the firm's procedures to note any issues prior to taking action. Thus, the docket record for the patent currently identifies correct maintenance fee due dates. A copy of the docket record is attached hereto as Exhibit C. It is my understanding that, due to limitations in the docketing and maintenance fee software, it is not possible to identify the specific employee and date on which the error was noted and corrected.

18. Believing the patent to be in force based on the firm's docketing and maintenance fee records, a maintenance fee due date reminder was forwarded to the client on June 18, 2004 by the Maintenance Fee Clerk at the time. (Ex. D.) Though my name is reflected on that document, I was no longer employed by the firm. It is therefore likely that my name was still in the system until the system was updated. When I started at the firm, the name of the prior Maintenance Fee Clerk was on documents for at least a week until the system was updated.

19. The reminder (Ex. D) indicated that the "Year 8 Tax" was due September 25, 2004. That date is automatically retrieved from the docketing software and reflects the docket and

maintenance fee record at the time. Thus, the error in docketing the 3.5 year maintenance fee due date was noted and corrected sometime prior to June 18, 2004.

20. It is my opinion that the person who noticed the erroneous deadline concluded that IPMaster merely indicated that the wrong fee was due – i.e., the 3.5 year fee, rather than the 7.5 year fee. It is important to note that the docketed date itself was correct (i.e., Sept. 25, 2004). It was only the indication that the “3.5 year fee” (rather than the “7.5 year fee”) was due, which was incorrect. Given such an unusual situation, it is certainly understandable that the person would not have recognized at that time, that the earlier fee had not been paid, even though it is my opinion that the firm had a reliable and trustworthy system and personnel in place for the firm’s most important business. In addition, the PTO confirmed receipt of the 7.5 year fee (see the PTO-stamped post card at Exhibit E, 2nd page thereto), and the firm never received any notice from the PTO that the 7.5 year fee was not accepted. Once the PTO-stamped post card is noted by the Maintenance Fee clerk, it is placed in the file and no further action is taken until the next maintenance fee reminder letter comes due.

21. However, a second clerical error occurred when the first clerical error was noted and corrected. Specifically, the second clerical error was the failure to note that the 3.5 year maintenance fee was not paid.

22. During my employment, the firm was handling very few reissue and reexamination proceedings. I am informed that reissue and reexamination cases represented less than about 2% of the patent cases being handled by the firm. In addition, at the time the first docketing error was noted, the only apparent error was the year (not the month and day) that the fee was due.

23. The client returned the reminder form to the firm on August 20, 2004, with instructions to pay the 7.5 year maintenance fee. A copy of the form returned by the client is attached hereto as Exhibit D. The client’s instructions were noted in the docket record for the subject patent. (See Exhibit C, Box 1; the boxes were added for purposes of identification.)

24. I was no longer employed by the firm on August 20, 2004. Based on information supplied to me, it is my understanding that a new Maintenance Fee Clerk had not yet been assigned, and that during that time, the Docketing Department was making payment of all maintenance fees.

25. As noted above, it was standard practice at the time of the above error to reconcile and resolve anomalies, inconsistencies, questions and the like prior to taking action, and before

any due date was cleared from the docket. However, the Docketing Department was not aware of the error in non-payment of the 3.5 year maintenance fee.

26. Authorization to charge the 7.5 year maintenance fee to Deposit Account No. 23-2185 was provided to the PTO on August 27, 2004, and receipt of said authorization was acknowledged by the PTO. Funds sufficient to process the 7.5 year maintenance fee were available in the deposit account on August 27, 2004. A copy of the authorization and acknowledgement is attached as Exhibit E. Transmittal of payment was noted in the docket record for the patent (see Exhibit C, Box 2).

27. The 7.5 year maintenance fee was timely paid with sufficient funds in the deposit account. And, the confirmation postcard (Exhibit E, 2nd page) confirmed that the Office received the documents. Thus, in accordance with the firm's procedures, maintenance fee statements and deposit account activity for the subject patent was not monitored. It was believed that the Office accepted payment of the 7.5 year maintenance fee and that the patent remained in force. A letter dated August 27, 2004, and addressed to the patent owner acknowledged receipt of the instructions to pay the 7.5 year maintenance fee and indicated that the fee had been paid or would be paid by the due date. A copy of this letter is attached hereto as Exhibit F.

28. No Notice of Non-Acceptance of Patent Maintenance Fee was received by the firm, otherwise it would appear in the docket record (Exhibit C).

29. I understand that the PTO states that it would have been reasonable to expect that the Petitioner might routinely check the status of the patent and that the maintenance fee was accepted by the PTO. It is my opinion, however, that it probably just did not occur to that person to check on the status of the 3.5 year maintenance fee. In hindsight, the PTO may think it would have been reasonable to check on the status of the 3.5 year maintenance fee at that time. However, it is likely that the error was corrected sometime from March-June, 18, 2004, which is when reminders would be sent to the client for the improperly-docketed 3.5 year deadline. It is important to keep in mind that the docketed date (*i.e.*, Sept. 25, 2004) was correct. It was only the notation that it was for the 3.5 year fee, rather than the 7.5 year fee, which was incorrect. Thus, at the time the error was discovered, it would have been natural to assume that the only error was the notation of which fee was due, especially since the date itself (Sept. 25, 2004) was correct.

30. Given such an unusual situation (of an improperly docketed reissue patent), it is certainly understandable that the person would not have recognized at that time, that the earlier fee had not been paid. In addition, the PTO confirmed receipt of the 7.5 year fee (see Exhibit E), and the firm never received any notice from the PTO that the 7.5 year fee was not accepted. Thus, the fact that these two clerical errors were made does not alter my opinion that the firm acted as a reasonable and prudent person would treat its most important business, and further that it exercised due care and had a reliable and trustworthy system in place to pay maintenance fees for its most important business, including for the present patent.

Dated: 22 Feb 2010

Respectfully,

By SueAnne Gill
SueAnne Gill